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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,366	04/14/2005	Per Sonne Holm	057982-138033	2065
90080 7590 03/03/2011				
Lisa Mueller c/o Polsinelli Shughart PC 161 N. Clark Street Suite 4200 Chicago, IL 60601				
EXAMINER				
SGAGIAS, MAGDALENE K				
ART UNIT		PAPER NUMBER		
1632				
NOTIFICATION DATE		DELIVERY MODE		
03/03/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/531,366

Applicant(s)

HOLM, PER SONNE

Examiner

MAGDALENE SGAGIAS

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 150-177 and 179-196 is/are pending in the application.
- 4a) Of the above claim(s) 150-177 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 179-185, 187-191, 193-196 is/are rejected.
- 7) ☐ Claim(s) 186 and 192 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 02/23/2011
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's arguments filed 10/27/2010 have been fully considered. Claims 150-177, 179-196 are pending. The amendment dated 10/27/2010 has been entered. Claims 1-149, 178 are canceled. Claims 150-177 are **withdrawn**. Claims 179-196 are under consideration.

Information Disclosure Statement

The IDS dated 02/23/2011 has been considered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The rejection of claims 179, 181, 183, 187, 195 under 35 U.S.C. 102(b) as being anticipated by Steegenga et al, (Oncogene, 16: 349-357, 1998 (IDS) is withdrawn in view of Steegenga et al, do not specifically teach E1A expression after to E1B or E4 or E1B and E4.

Applicant's arguments are convincing therefore the rejection is withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The rejection of claims 179, **180**, 181, 183, 187, 195 under 35 U.S.C. 103(a) as being unpatentable over by **Steegenga et al**, [(Oncogene, 16: 349-357, 1998 (IDS) thereafter referred as Steegenga, 1998)] in view of **Fueyo et al** (20050260162) is withdrawn in view of Steegenga et al, do not specifically teach E1A expression prior to E1B or E1 or E1B and E4.

Applicant's arguments are convincing therefore the rejection is withdrawn.

The rejection of claims 179, 181, **182**, 183, 187, 195 under 35 U.S.C. 103(a) as being unpatentable over by **Steegenga et al**, [(Oncogene, 16: 349-357, 1998 (IDS) thereafter referred as Steegenga, 1998)] in view of **Steenenga et al**, [(Molecular and Cellular Biology, 19(5): 3885-3894, 1999 (previously cited) thereafter referred as Steegenga, 1999 is withdrawn in view of Steegenga et al, do not specifically teach E1A expression prior to E1B or E1 or E1B and E4.

Applicant's arguments are convincing therefore the rejection is withdrawn.

The rejection of claims 179, 181, 182, **183-196** under 35 U.S.C. 103(a) as being unpatentable over by Steegenga et al, [(Oncogene, 16: 349-357, 1998 (IDS) thereafter referred as Steegenga, 1998)] in view of Steenenga et al, [(Molecular and Cellular Biology, 19(5): 3885-3894, 1999 (previously cited) thereafter referred as Steegenga, 1999)] and further in view of **Irving et al** (20030095989); of **Li et al**, (Cancer Research, 61: 6428-6436, 2001 (previously cited)) is withdrawn in view of Steegenga et al, do not specifically teach E1A expression prior to E1B or E1 or E1B and E4.

Applicant's arguments are convincing therefore the rejection is withdrawn.

Obviousness Type Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Omum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321 (d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 179-185, 187-191, 193-196 **remain** provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 47-51, 53, 59-60, 65 of copending Application No. 10/451,210. The instant claims recite the YB-1 sequence is under the control of a promoter while the '210 do not explicitly recite a promoter for this sequence. It would have been obvious for the ordinary skilled artisan to make a choice of between a first polypeptide comprising an E1B polypeptide, an E4 polypeptide or an E1B and E4 because expression of the E1B and E4 sequence is essential for operation of the adenoviral replication system recited in the '210 claims. The claims are therefore obvious one over the other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants request to hold the rejection in abeyance until there is allowable subject

Allowable Subject Matter

Claims 186, 192 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Magdalene K. Sgagias whose telephone number is (571) 272-3305. The examiner can normally be reached on Monday through Friday from 9:00 am to 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras, Jr., can be reached on (571) 272-4517. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Magdalene K. Sgagias,
Art Unit 1632

/Thaia N. Ton/
Primary Examiner, Art Unit 1632